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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,708	<b>Applicant(s)</b> MORI ET AL.	
	<b>Examiner</b> Matthew J. Ludwig	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period, for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This document is a Non-Final Office Action on the merits. This action is responsive to the following communications: RCE, which was filed on 11/17/2006.
2. Claims 1-25 are currently pending in the case, with claims 1, 7, 13, 17, 18, 19, 20, and 23 being the independent claims.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claims 1,7,18 20, and 23, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to claims 1, 7, 18, 20, and 23, the claims recite the phrase 'an attribute of the new group from an attribute of the original group and an attribute prepared in advance'. The language 'prepared in advance' seems to be incomplete as it fails to describe in advance of something being done but it end with the word advance. If the reference is preparing an attribute in advance of an explicit event than that event should be described or the phrase 'prepared in advance' should be removed from the limitations of the independent claims.

### *Claims Rejection – 35 U.S.C. 103*

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usami, et al (U.S. Patent 5,363,480, issued November 8, 1994) [hereinafter "Usami"] in view of Orr, et al. (U.S. Patent 5,895,477, issued April 20, 1999) [hereinafter "Orr"].**

Regarding **independent claim 1 & 19, as amended**, Usami in view of Orr teaches:

*A document processing apparatus for a structured document formed by at least one group having a specific attribute, wherein each of the at least one group contains at least one page, each of which has a print attribute, said apparatus comprising:*

*a display controller which controls display of an object as an image indicating at least one original page contained in the document;*

*an instruction unit which accepts an instruction from a user to insert a new page into the document, on a screen on which the object is displayed as the image by said display controller; and*

*an editor which edits the document so as to generate a new group containing the new page and to insert the new group into the document in accordance with the instruction accepted by said instruction unit,*

*wherein said display controller controls display of the objects including an object corresponding to the new group, using the document edited by said editor.*

(Usami teaches a multiple page display for word processing including editing with a display controller that displays images of the original pages, but it does not expressly teach displaying a document structure with and original page contained in the object and does not teach an inserting a new group of pages.

Orr teaches a display controller that displays document structure and the original pages, and further, teaches the insertion of a plurality of objects to the original documents via a tree structure, and such object may include pages.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Usami with Orr to result in a word processing program that displayed the document by pages and to make insertions by pages because both programs deal with the creation and manipulation of electronic documents. Suggestion for a page by page insertion according to the invention of Orr is taught by Orr in Figures 1 and 2, teaching a saved document that is edited through a user interface with an associated edited version which is then processed to a multi-page information presentation.). The multipage presentation illustrated in figure 1C is an example of a group (wherein one group contains at least one page) with the page divided into three different pages and each page including the image. This would suggest dividing an original group including pages. Also, the page illustrated in figure 1B provides the layout prior to the author editing the webpage (HTML document) and moving a page from the original group. See column 7, lines 1-67 and column 8, lines 11-67.

The selection step of accepting a selection of an attribute to be employed as an attribute of the new group from an attribute of the original group and an attribute prepared in advance and a setting step of setting an attribute of the new group in accordance with the selection accepted in

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said selection step are both suggested in the Orr when the reference describes the movement of images (attributes) from one page and dividing the page into three pages and accepting the image (attribute) from the old group into the new group. A setting step is suggested by the publish command selected by an author in response to the attribute of the new group being in accordance with his/her own preferences or the preferences of the design engine. See column 10, lines 15-40.

Regarding **dependent claim 2, as amended**, Usami in view of Orr teaches:

*The apparatus according to claim 1, wherein said display controller displays a selection window capable of selecting whether to edit the document so as to insert the new group containing the designated original page to a designated position or whether to move a designated original page to the designated position in accordance with designation of the original page and the position of the objects, and said editor performs editing processing in accordance with selection in the selection window.*

(See rejection of Claim 1, above, and see also, Orr, Figures 1-2, teaching an editing window with "File," "Edit," "View," and "Insert" functions.)

Regarding **dependent claim 3, as amended**, Usami in view of Orr teaches:

*The apparatus according to claim 1, wherein the group has a group attribute, and said editor causes the new inserted group to inherit an attribute of the group.*

(See rejection of Claim 1, above, and see also, Orr, col. 3, lines 27-34, teaching matching the edited content to the original content.)

Regarding **dependent claim 4**, Usami in view of Orr teaches:

*The apparatus according to claim 1, wherein the group has a group attribute, and said editor gives a predetermined attribute to the new inserted group.*

(See rejection of Claim 1, above, and see also, Orr, col. 3, lines 27-34, teaching matching the content to new components in the design tree.)

Regarding **dependent claim 5, as amended**, Usami in view of Orr teaches:

*The apparatus according to claim 1, wherein the group has a group attribute, said editor causes said display controller to display a selection window capable of selecting whether to cause the new inserted group to inherit an attribute of the group, or whether to give a predetermined attribute, and said editor performs editing processing in accordance with selection in the selection window.*

(See rejection of Claim 1, above, and see also, Orr, claim 7, teaching use of a content drop table to determine the content type to be used.)

Regarding **dependent claim 6**, Usami in view of Orr teaches:

*The apparatus according to claim 1, wherein the group of the original pages is made to correspond to a layer of a data structure having at least one chapter which forms a document, and at least one original page is made to correspond to a lower layer of the data structure of the chapter.*

(See rejection of Claim 1, above. In addition, since the invention displays a series of pages, it would be obvious to one of ordinary skill in the art at the time of the invention that the pages

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displayed may constitute a chapter that forms a document. Further, see, Orr, Figure 31, teaching that the original page may be modified to any form in the tree structure.)

Regarding **claims 7-12, as amended**, claims 7-12 incorporate substantially similar subject matter as claimed in claims 1-6, respectively, and are rejected along the same rationale.

Regarding **independent claim 13**, Usami in view of Orr teaches:

*A document processing method of processing original data having a print format as an attribute, comprising steps of:*

*holding original data in a tree structure by giving an attribute to each node; and  
when separating arbitrary partial tree data in the tree structure into a plurality of partial tree data, replacing an attribute of each separated partial tree with an attribute of a node of the partial tree data in accordance with an attribute before separation.*

(Usami teaches a multiple page display for word processing including editing with a display controller that displays images of the original pages, but it does not expressly teach displaying a document structure with and original page contained in the object and does not teach an inserting a new group of pages.

Orr teaches a display controller that displays document structure and the original pages, and further, teaches the insertion of a plurality of objects to the original documents via a tree structure, and such object may include pages. In addition, Orr teaches a “design facet” that is part of the “design tree” of the composition tree structure. See, Orr, Figures 5A-7, and col. 15,



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line 62 through col. 16, lines 51. Further, see, Orr, col. 26, lines 26-32, teaching that the attribute of text in a dropped object may be changed or stay the same according to different user choices.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Usami with Orr to result in a word processing program that displayed the document by pages and to make insertions by pages with and without attribute modifications because both programs deal with the creation and manipulation of electronic documents. Suggestion for a page by page insertion according to the invention of Orr is taught by Orr in Figures 1 and 2, teaching a saved document that is edited through a user interface with an associated edited version which is then processed to a multi-page information presentation.)

Regarding **dependent claim 14**, Usami in view of Orr teaches:

*The method according to claim 13, wherein the attribute of the separated partial tree includes an attribute value before separation.*

(See rejection of claim 14 above, and, in addition, see Orr, col. 26, lines 26-31, teaching that the attributes of the added material (separated partial tree) may retain its original attributes.)

Regarding **dependent claim 15**, Usami in view of Orr teaches:

*The method according to claim 13, wherein the attribute of the separated partial tree includes an attribute value designated by a user.*

(See rejection of claim 14 above, and, in addition, see Orr, claim 7, teaching that the attributes of the added material (separated partial tree) may be selected by the user from a content drop table.)

Regarding **dependent claim 16**, Usami in view of Orr teaches:

*The method according to claim 13, wherein the attribute of the separated partial tree can be selectively applied by a user from a plurality of attribute setting methods.*

(See rejection of claim 14 above, and, in addition, see Orr, claim 7, teaching that the attributes of the added material (separated partial tree) may be selected by the user from a content drop table.)

Regarding **independent claim 17**, Usami in view of Orr teaches:

*A document processing apparatus which processes original data having a print format as an attribute, comprising:*

*a holding unit which holds original data in a tree structure by giving an attribute to each node; and*

*a replacement unit which, when arbitrary partial tree data in the tree structure held by said holding unit is separated into a plurality of partial tree data, replaces an attribute of each separated partial tree with an attribute of a node of the partial tree data in accordance with an attribute before separation.*

(Usami teaches a multiple page display for word processing including editing with a display controller that displays images of the original pages, but it does not expressly teach displaying a document structure with and original page contained in the object and does not teach an inserting a new group of pages.

Orr teaches a display controller that displays document structure and the original pages, and further, teaches the insertion of a plurality of objects to the original documents via a tree structure, and such object may include pages. In addition, Orr teaches a “design facet” that is part of the “design tree” of the composition tree structure. See, Orr, Figures 5A-7, and col. 15,

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line 62 through col. 16, lines 51. Further, see, Orr, col. 26, lines 26-32, teaching that the size attribute of text, which is a print attribute, in a dropped object may be changed or stay the same according to different user choices.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Usami with Orr to result in a word processing program that displayed the document by pages and to make insertions by pages with and without attribute modifications because both programs deal with the creation and manipulation of electronic documents. Suggestion for a page by page insertion according to the invention of Orr is taught by Orr in Figures 1 and 2, teaching a saved document that is edited through a user interface with an associated edited version which is then processed to a multi-page information presentation.)

Regarding **independent claim 18**, Usami in view of Orr teaches:

*A program stored on a computer readable storage medium, said program for causing a computer to process a structured document formed by at least one group having a specific attribute, wherein each of the at least one group contains at least one page, each of which has a print attribute, wherein the program comprises:*

*code for a display control step of controlling display of an object as an image indicating at least one original page contained in the document;*

*a code for an instruction accepting step of accepting an instruction from a user to insert a new page into the document, on a screen on which the object is displayed as the image in said display control step; and*

*code for an editing step of editing the document so as to generate a new group containing the new page and to insert the new group into a document in accordance with the instruction accepted in said instruction accepting step,*

*wherein in the display control step, display of the image objects, including an object corresponding to the new group, is controlled using the document edited in the editing step.*

(Usami teaches a multiple page display for word processing including editing with a display controller that displays images of the original pages, but it does not expressly teach displaying a document structure with and original page contained in the object and does not teach an inserting a new group of pages.

Orr teaches a display controller that displays document structure and the original pages, and further, teaches the insertion of a plurality of objects to the original documents via a tree structure, and such object may include pages. In addition, Orr teaches a “design facet” that is part of the “design tree” of the composition tree structure. See, Orr, Figures 5A-7, and col. 15, line 62 through col. 16, lines 51. Further see, Orr, Figures 1-2, and 29, teaching control of the object in the editing step.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Usami with Orr to result in a word processing program that displayed the document by pages and to make insertions by pages with and without attribute modifications because both programs deal with the creation and manipulation of electronic documents. Suggestion for a page by page insertion according to the invention of Orr is taught

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by Orr in Figures 1 and 2, teaching a saved document that is edited through a user interface with an associated edited version which is then processed to a multi-page information presentation.) The multipage presentation illustrated in figure 1C is an example of a group (wherein one group contains at least one page) with the page divided into three different pages and each page including the image. This would suggest dividing an original group including pages. Also, the page illustrated in figure 1B provides the layout prior to the author editing the webpage (HTML document) and moving a page from the original group. See column 7, lines 1-67 and column 8, lines 11-67.

The selection step of accepting a selection of an attribute to be employed as an attribute of the new group from an attribute of the original group and an attribute prepared in advance and a setting step of setting an attribute of the new group in accordance with the selection accepted in said selection step are both suggested in the Orr when the reference describes the movement of images (attributes) from one page and dividing the page into three pages and accepting the image (attribute) from the old group into the new group. A setting step is suggested by the publish command selected by an author in response to the attribute of the new group being in accordance with his/her own preferences or the preferences of the design engine. See column 10, lines 15-40.

**Claims 20-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Orr, et al. (U.S. Patent 5,895,477, issued April 20, 1999) [hereinafter "Orr"].

Regarding **independent claim 20**, Orr teaches:

*A document processing apparatus for processing document data containing chapters, each of which contains pages, comprising:*

*obtainment means for obtaining data containing pages; and*

*generation means for, when said obtainment means has obtained data containing pages, generating a new chapter which is different from chapters currently contained in the document data and which contains the pages obtained by said obtainment means.*

(See, Orr, figures 19-22, and 38, and col. 23, line 63 through col. 26, line 44, teaching the insertion of a word processing document into another document.

Orr does not expressly teach that the document “contains chapters.” It would have been obvious to one of ordinary skill in the art that insertion of word processing text into a document may include a situation wherein the document is a part of a book or a “chapter.”

The Examiner takes official notice of the fact that it was well known by one of ordinary skill in the art at the time of the invention that word processors were used to write books with the ability to edit the text in the books, that some form of “attainment means” was used for identifying content to be edited into a word processing document, and that such editing was done with such commonly available word processing programs as Wordstar, Word Perfect, and Microsoft Word. It was further well known that books may include chapters, and that the editing of text in a book may result in the editing of text in a chapter to result in a “new chapter.” It is inherent that insertion of a new word processing document into a old document results in a new combined document. Therefore, it is also inherent that if the old document was a “chapter,” as was well known to one of ordinary skill in the art at the time of the invention, the new combined document would, necessarily and inherently, be a “new chapter which is different

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from chapters currently contained in document data.”). The multipage presentation illustrated in figure 1C is an example of a group (wherein one group contains at least one page) with the page divided into three different pages and each page including the image. This would suggest dividing an original group including pages. Also, the page illustrated in figure 1B provides the layout prior to the author editing the webpage (HTML document) and moving a page from the original group. See column 7, lines 1-67 and column 8, lines 11-67.

The selection step of accepting a selection of an attribute to be employed as an attribute of the new group from an attribute of the original group and an attribute prepared in advance and a setting step of setting an attribute of the new group in accordance with the selection accepted in said selection step are both suggested in the Orr when the reference describes the movement of images (attributes) from one page and dividing the page into three pages and accepting the image (attribute) from the old group into the new group. A setting step is suggested by the publish command selected by an author in response to the attribute of the new group being in accordance with his/her own preferences or the preferences of the design engine. See column 10, lines 15-40.

Regarding **dependent claim 21**, Orr teaches:

*An apparatus according to claim 20, wherein said obtainment means obtains data containing pages by import, and*

*said generation means generates a new chapter containing the pages obtained by said obtainment means by import to insert the new chapter into the document data.*

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(See, Orr, col. 24, lines 4-56, teaching an obtainment means by “import” identifying means of import such as file name, URL address, computer interface, computer network, etc.

See, Orr, col. 23, line 63 through col. 26, line 44, teaching “inserting” as “dropping” to generate a new document.

As discussed in rejection of claim 21, above, the document of as a “chapter” would have been obvious to one of ordinary skill in the art at the time of the invention.)

Regarding **dependent claim 22**, Orr teaches:

*An apparatus according to claim 20, wherein, in response to an instruction to divide a chapter contained in the document data, said obtainment means obtains data containing pages constituting a portion of the chapter instructed to be divided, and said generation means generates a new chapter containing the pages obtained by said obtainment means to insert the new chapter into the document data.*

(See, Orr, figures 19-21, and col. 24, line 57 through col. 26, line 44, teaching dividing a document and that new text is inserted into the document, which may be pages inserted into a chapter, and a new chapter is created. Orr does not expressly teach that the new document is a chapter. As discussed in rejection of claim 21, above, the document of as a “chapter” would have been obvious to one of ordinary skill in the art at the time of the invention.)

Regarding **claims 23-25**:

Claims 23-25 incorporate substantially similar subject matter as claimed in claims 20-22 and are rejected along the same rationale.



3. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

### *Response to Arguments*

7. Applicants' arguments filed April 14, 2006 have been fully considered, but they are not persuasive.

Applicant argues on page 12 and 13 of the amendment that neither reference teaches or suggests 'the amendment contains 'divide an original group including pages', 'a selection unit which accepts a selection of an attribute to be employed as an attribute of the new group from an attribute of the original group and an attribute prepared in advance', and 'a setting unit which sets an attribute of the new group in accordance with the selection accepted by said selection unit'. The Examiner believes the newly formed claim limitations are taught/suggested by the Orr reference. Therefore, the rejections have been adjusted accordingly.

### *Conclusion*

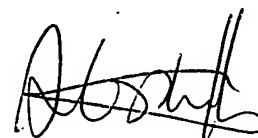
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 9:00am-6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER